

## **REMARKS**

### **The Amendments**

Claims 1 and 12 are amended as to the definition of the Z<sup>1</sup> and Z<sup>2</sup> groups. Support for the modified definition is evident from the disclosure as a whole, e.g., all the specifically recited compounds in the specification (e.g., formulae I1 to I32) are those wherein Z<sup>1</sup> is -CF<sub>2</sub>O- and Z<sup>2</sup> is -COO-. Claims 1 and 12 are further amended to exclude, by proviso, the intermediate compounds disclosed or implied in Example 8 of the Matsui reference. The claims are further amended to correct obvious informalities. These latter amendments do not narrow the scope of the claims and/or were not made for reasons related to patentability.

To the extent that the amendments avoid the prior art or for other reasons related to patentability, competitors are warned that the amendments are not intended to and do not limit the scope of equivalents which may be asserted on subject matter outside the literal scope of any patented claims but not anticipated or rendered obvious by the prior art or otherwise unpatentable to applicants. Applicants reserve the right to file one or more continuing and/or divisional applications directed to any subject matter disclosed in the application which has been canceled by any of the above amendments.

### **The Rejection under 35 U.S.C. §102 over Matsui**

The rejection of claims 12-13 under 35 U.S.C. §102, as being anticipated by Matsui (U.S. Patent No. 5,858,270) is respectfully traversed.

As pointed out in the Office Action, Matsui discloses the compound 4-trifluoromethoxyphenyl-[4-(difluoro-(4-propylphenyl)methoxy)benzoate]. This compound is disclosed merely as an intermediate in preparing the compound of Example 8; see, e.g.,

cols. 247-252 of Matsui. Similar intermediates are implied by the reference to use of analogous processes for preparing the other compounds of Example 8.

Regarding claim 13, it is pointed out that the 4-trifluoromethoxyphenyl-[4-(difluoro-(4-propylphenyl)methyloxy)benzoate] compound of Matsui does not anticipate applicants' formula I4. As do all the compounds of claim 13, formula I4 contains a cyclohexyl ring on the left-hand side of the formula, i.e. the A ring. The Matsui compound has three phenyl rings and no cyclohexyl ring. Thus, formula I4 – nor any other formula of claim 13 – is anticipated by this Matsui compound or any other compound specifically taught by Matsui.

Regarding claim 12, this claim does encompass the possibility of the A ring being a phenyl ring. However, a proviso has been added into claim 12 – and also claim 1 – to exclude the 4-trifluoromethoxyphenyl-[4-(difluoro-(4-propylphenyl)methyloxy)benzoate] compound of Matsui. The proviso further excludes analogous compounds to this intermediate which would be the other intermediate compounds apparently inferred for preparing the other final compounds of Example 8 of Matsui; i.e., the variant substitutions on the phenyl rings. It is submitted that Matsui fails to provide any specific disclosure of any compound falling within the scope of applicants' instant claim 12.

Accordingly, the rejection under 35 U.S.C. §102 over Matsui should be withdrawn.

Matsui also fails to provide any basis for an obviousness rejection under 35 U.S.C. §103. The Matsui compounds discussed and distinguished are merely intermediates used to prepare the Matsui final products. No motivation exists to modify compounds, which are taught only as intermediates, to arrive at compounds having a utility other than as an intermediate. In re Lalu, 223 USPQ 1257, (Fed. Cir. 1984). In the absence of motivation, obviousness cannot be supported.

**The Rejection under 35 U.S.C. §102 or §103 over DE 19949333**

The rejection of claims 1-12 and 14-18 under 35 U.S.C. §102, as being anticipated by, or under 35 U.S.C. §103, as being obvious over, DE 19949333 ("DE '333") is respectfully traversed.

DE '333 discloses liquid crystalline compounds of the formula I therein. These compounds contain a -COO- bridging group at the position corresponding to Z<sup>1</sup> of the instant claims and a Z bridging group at the position corresponding to Z<sup>2</sup> of the instant claims. In formula If - Ih, the Z bridging group may be -CF<sub>2</sub>O- or -OCF<sub>2</sub>-.

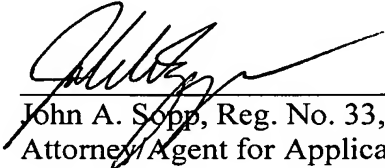
These compounds of DE '333 do not fall within the scope of the instant claims. Compare the definitions of Z<sup>1</sup> and Z<sup>2</sup> in the instant claims, as amended. In the instant claims Z<sup>1</sup> is the -CF<sub>2</sub>O- group and Z<sup>2</sup> is the -COO- group, i.e., opposite from the type of compounds disclosed in DE '333. Thus, DE '333 fails to anticipate the instant claims.

DE '333 also fails to render the instant claims obvious under 35 U.S.C. §103. The general formula I for the DE '333 compounds specifically requires that the -COO- bridging group be provided at the position corresponding to applicants Z<sup>1</sup> position. There is no suggestion from the reference to modify that bridging group to replace -COO- with -CF<sub>2</sub>O-. To the contrary, such a modification would appear to be contrary to the express teachings of the reference. Given the otherwise general nature of several other structural aspects of formula I of DE '333, one of ordinary skill in the art would be directed away from modifying this bridging group which is specifically and expressly required by the reference teachings. The direction away from making such a modification is the anti-thesis of motivation to modify. Thus, the necessary motivation for an obviousness rejection is lacking and the rejection under 35 U.S.C. §103 should be withdrawn.

It is submitted that the claims are in condition for allowance. However, the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

  
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